

R E M A R K S

This is in response to the Office Action that was mailed on May 28, 2003. Claims 1, 3-9, and 15 are cancelled, without prejudice, in order to advance the prosecution of this application. Claim 16 is amended to be in independent form. No new matter is introduced by this Amendment. Entry of this Amendment in order to place the application into condition for allowance, or into better condition for appeal, is respectfully solicited. With this Amendment, claims 10-14 and 16 are in the case.

Kimura) in view of US 5,231,207 (Yanagisawa) and US 5,286,766 (Arai). The rejection is respectfully traversed.

The presently claimed invention is a composition that comprises components identified as (A), (B), and (C). The Examiner alleges that Kimura teaches component (B), but acknowledges that Kimura fails to teach component (C) and component (A). Office Action, page 4, 3rd full paragraph. Using Applicant's claim as a guide, the Examiner has located a second reference (Arai) which allegedly teaches component (A) and has located a third reference (Yanagisawa) which allegedly teaches component (C).

The number of different references combined by the Examiner to reject the claims herein raises the question of whether the rejection as stated involves improper hindsight. The rigorous burden placed upon an Examiner for establishing a *prima facie* case of obviousness has recently been reviewed by the United States Court of Appeals for the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, (Fed. Cir. 2002). In *Lee*, the court observes:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and

combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the *Graham* factors).

... *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).

It is respectfully urged that the Examiner has not met his burden of proof with respect to the rejection of record.

Specifically, the Examiner argues that the motivation to substitute the hydroxy-terminated polysiloxanes of Kimura with the alkoxy-terminated polysiloxanes of Arai is that Arai teaches that the silanol-terminated polysiloxanes cause shelf-life problems that can be overcome through the use of alkoxy-terminated polysiloxanes. Office Action, page 5, 2nd full paragraph. The Examiner also argues that Yanagisawa teaches that the aminosilane compounds of his invention are an improvement over the silane preferred by Kimura. Office Action, paragraph bridging pages 5-6. Therefore, the Examiner reasons, one of ordinary skill in the art at the time the present invention was made would have modified the Kimura compositions to provide the compositions that Applicant is now claiming.

The difficulty with this reasoning is the fact that the Arai teaching was known to those of ordinary skill in the art in 1994 and the Yanagisawa teaching was known to those of ordinary skill in the art in 1993, yet when Kimura (by definition a person of skill in the art) filed his application subsequent to those dates, he did not make those allegedly obvious and motivated improvements. This chronology contradicts the Examiner's allegations of obviousness.

Clearly, allowance of the present claims will not deprive the public of technology that was in its possession prior to Applicant's disclosure thereof. One of ordinary skill in the art, given the knowledge available to the prior art when Applicant made his invention, would not have conceived of a composition having components (A), (B), and (C) as defined herein – as is evidenced by the Kimura reference itself!

Claims 1, 3-7, and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,300,611 (Fujioka) in view of Yanagisawa. Claim 8 was rejected as being unpatentable over Fujioka in view of Yanagisawa and Arai. Claim 9 was rejected as being unpatentable over Fujioka in view of Yanagisawa and US 4,721,765 (Inoue). All of these rejections are rendered moot by the cancellation (without prejudice) of the claims in question.

Objection was raised to claim 16. The Examiner indicated that Applicant could overcome the objection by rewriting the claim in independent form. Office Action, page 2, first full paragraph. Applicant has done so, hereinabove.

The Examiner indicated that claims 7 and 15 were identical. That issue is obviated by the cancellation without prejudice of those claims.

Conclusion

If the Examiner still does not believe that this application is in condition for allowance, he is requested to contact Richard Gallagher, Reg. No. 28,781, at (703) 205-8008, in order to conduct an interview to advance the prosecution of this application.

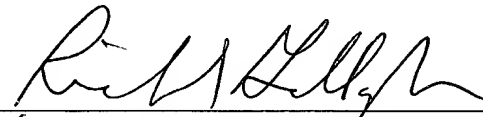
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit

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Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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